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10/561,236

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Guido Grandi

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NOVARTIS VACCINES AND DIAGNOSTICS INC.

INTELLECTUAL PROPERTY- X100B

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EXAMINER

MINNIFIELD, NITA M

ART UNIT

PAPER NUMBER

1645

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/561,236

Applicant(s)

GRANDI ET AL.

Examiner

N. M. Minnifield

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 2,9,11,17-21 and 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,12-16 and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/13/07, 10/4/10</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's election of Group I and species LcrE, CT398 and HtrA in the reply filed on October 4, 2010 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 2, 9, 11, 17-21 and 26-32 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on October 4, 2010.

3. The use of trademarks has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, see page 63. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

5. The drawings are objected to because Figures 7(b) and 9(b) are too grainy, bar graphs are of poor quality. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of

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the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 7, 13 and 23-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

The claims recite "oligonucleotides comprising CpG motifs" and that it is an adjuvant. Neither the claims nor the specification provide any other information regarding the CpG; only two nucleotides have been defined. The function is that of an immunostimulant since it is an adjuvant (see claims).

The MPEP § 2163.02 states, "[a]n objective standard for determining compliance with the written description requirement is, 'does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed' ". The courts have decided: The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed. See *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Federal Circuit, 1991).

Furthermore, the written description provision of 35 USC § 112 is severable from its enablement

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provision; and adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. See *Fiers v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. The Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, paragraph 1, "Written Description" Requirement (66 FR 1099-1111, January 5, 2001) state, "[p]ossession may be shown in a variety of ways including description of an actual reduction to practice, or by showing the invention was 'ready for patenting' such as by disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention" (Id. at 1104). Moreover, because the claims encompass a genus of compositions, an adequate written description of the claimed invention must include sufficient description of at least a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics sufficient to show that Applicant was in possession of the claimed genus. However, factual evidence of an actual reduction to practice has not been disclosed by Applicant in the specification; nor has Applicant shown the invention was "ready for patenting" by disclosure of drawings or structural chemical formulas that show that the invention was complete; nor has Applicant described distinguishing identifying characteristics sufficient to show that Applicant were in possession of the claimed invention at the time the application was filed.

The Guidelines further state, "[f]or inventions in an unpredictable art, adequate written description of a genus which embraces widely variant species cannot be achieved by disclosing only one species within the genus" (Id. at 1106); accordingly, it follows that an adequate written description of a genus cannot be achieved in the absence of a disclosure of at least one species within the genus. Therefore, absent a detailed and particular description of a representative number, or at least a substantial number of the members of the genus of compositions, the skilled artisan could not immediately recognize or distinguish members of the claimed antigenic compositions. In view of the above, the instant specification fails to meet the written description requirement as set forth under 35 U.S.C. 112, first paragraph.

A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed

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from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a “laundry list” disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not “reasonably lead” those skilled in the art to any particular species); *In re Ruschig*, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967) (“If n-propylamine had been used in making the compound instead of n-butylamine, the compound of claim 13 would have resulted. Appellants submit to us, as they did to the board, an imaginary specific example patterned on specific example 6 by which the above butyl compound is made so that we can see what a simple change would have resulted in a specific supporting disclosure being present in the present specification. The trouble is that there is no such disclosure, easy though it is to imagine it.”) (emphasis in original); *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000) (“the specification does not clearly disclose to the skilled artisan that the inventors ... considered the ratio... to be part of their invention .... There is therefore no force to Purdue’s argument that the written description requirement was satisfied because the disclosure revealed a broad invention from which the [later-filed] claims carved out a patentable portion”).

The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by a functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence. For example, even though a genetic code table would correlate a known amino acid sequence with a genus of coding nucleic acids, the same table cannot predict the native, naturally occurring nucleic acid sequence of a naturally occurring mRNA or its corresponding cDNA. Cf. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993), and *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995) (holding that a process could not render the product of that process obvious under 35 U.S.C. 103). The Federal Circuit has pointed out that under United States law, a description that does not render a claimed invention obvious cannot sufficiently describe the invention for the purposes of the written description requirement of 35 U.S.C. 112. *Eli Lilly*, 119 F.3d at 1567, 43

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USPQ2d at 1405. Compare *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997) (“As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.”). MPEP 2163

A specification may describe an actual reduction to practice by showing that the inventor constructed an embodiment or performed a process that met all the limitations of the claim and determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327, 47 USPQ2d 1896, 1901 (Fed. Cir. 1998). See also *UMC Elecs. Co. v. United States*, 816 F.2d 647, 652, 2 USPQ2d 1465, 1468 (Fed. Cir. 1987) (“[T]here cannot be a reduction to practice of the invention without a physical embodiment which includes all limitations of the claim.”); *Estee Lauder Inc. v. L’Oreal, S.A.*, 129 F.3d 588, 593, 44 USPQ2d 1610, 1614 (Fed. Cir. 1997) (“[A] reduction to practice does not occur until the inventor has determined that the invention will work for its intended purpose.”); *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1578, 38 USPQ2d 1288, 1291 (Fed. Cir. 1996) (determining that the invention will work for its intended purpose may require testing depending on the character of the invention and the problem it solves). Description of an actual reduction to practice of a biological material may be shown by specifically describing a deposit made in accordance with the requirements of 37 CFR 1.801 et seq. See especially 37 CFR 1.804 and 1.809. See also paragraph I., supra. MPEP 2163 This actual reduction to practice of the claimed invention is not set forth in the instant specification.

For some biomolecules, examples of identifying characteristics include a sequence, structure, binding affinity, binding specificity, molecular weight, and length. Although structural formulas provide a convenient method of demonstrating possession of specific molecules, other identifying characteristics or combinations of characteristics may demonstrate the requisite possession. >As explained by the Federal Circuit, “(1) examples are not necessary to support the adequacy of a written description; (2) the written description standard may be met ... even where actual reduction to practice of an invention is absent; and (3) there is no per se rule that an

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adequate written description of an invention that involves a biological macromolecule must contain a recitation of known structure.” *Falkner v. Inglis*, 448 F.3d 1357, 1366, 79 USPQ2d 1001, 1007 (Fed. Cir. 2006). See also *Capon v. Eshhar*, 418 F.3d at 1358, 76 USPQ2d at 1084 (“The Board erred in holding that the specifications do not meet the written description requirement because they do not reiterate the structure or formula or chemical name for the nucleotide sequences of the claimed chimeric genes” where the genes were novel combinations of known DNA segments.).< For example, disclosure of an antigen fully characterized by its structure, formula, chemical name, physical properties, or deposit in a public depository provides an adequate written description of an antibody claimed by its binding affinity to that antigen. *Noelle v. Lederman*, 355 F.3d 1343, 1349, 69 USPQ2d 1508, 1514 (Fed. Cir. 2004) (holding there is a lack of written descriptive support for an antibody defined by its binding affinity to an antigen that itself was not adequately described). Additionally, unique cleavage by particular enzymes, isoelectric points of fragments, detailed restriction enzyme maps, a comparison of enzymatic activities, or antibody cross-reactivity may be sufficient to show possession of the claimed invention to one of skill in the art. See *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966 (“written description” requirement may be satisfied by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention”). A definition by function alone “does not suffice” to sufficiently describe a coding sequence “because it is only an indication of what the gene does, rather than what it is.” *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406. See also *Fiers*, 984 F.2d at 1169-71, 25 USPQ2d at 1605-06 (discussing *Amgen Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991)).

An adequate written description of a chemical invention also requires a precise definition, such as by structure, formula, chemical name, or physical properties, and not merely a wish or plan for obtaining the chemical invention claimed. See, e.g., *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 927, 69 USPQ2d 1886, 1894-95 (Fed. Cir. 2004) (The patent at issue claimed a method of selectively inhibiting PGHS-2 activity by administering a non-steroidal compound that selectively inhibits activity of the PGHS-2 gene product, however the patent did not disclose any compounds that can be used in the claimed methods. While there was a description of assays for screening compounds to identify those that inhibit the expression or



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activity of the PGHS-2 gene product, there was no disclosure of which peptides, polynucleotides, and small organic molecules selectively inhibit PGHS-2. The court held that “[w]ithout such disclosure, the claimed methods cannot be said to have been described.”).

It is noted that Applicants have claimed a large genus of CpG adjuvants, with only the C and G being defined in the CpG immunostimulatory nucleic acid. The state of the art with regard to the CpG oligonucleotides and stimulating a Th-1 immune response (i.e. adjuvant) is unpredictable. The state of the art teaches that there are a number of specific characteristics of the oligonucleotide, which are critical for its function as an immunostimulatory molecule. For instance, Krieg (BioDrugs 1998, 5:341-346) teaches that synthetic oligonucleotides ranging in length from 8 to 30 nucleotides or more could cause immune stimulation if there was only a single CpG dinucleotide as long as this was not preceded by a C or followed by a G. Most importantly, the CpG dinucleotide had to be unmethylated: if the C was replaced by s-methylcytosine, then the oligonucleotide lost its immune stimulatory activity (p. 342). The pending claims do not recite that the C or G is unmethylated. Yamamoto et al 1994 (Antisense Research and Development, 1994, 4:119-122) teaches that “immunostimulatory activity of oligonucleotides 18 bases or more in length was observed and was proportional to the base length, with a maximum at 22-30 bases. On the other hand, the oligonucleotides 16 bases or less in length were not as active even if they possessed the palindromic sequences. These results indicate that the immunostimulatory activity of oligonucleotides with certain palindromic sequences requires an oligonucleotide at least 18 bases long.” (abstract). Agrawal et al. (Trends in Mol. Med., 2002; 8:114-121) teaches that the pattern and kinetics of induction of the cytokines in vivo depends on the sequences flanking the CpG dinucleotide, as well as the dose, the route of administration and the host animal species (see page 16 "therapeutic potential of CpG DNA" in particular) and that there is a species-dependent selectivity of CpG DNA, and that the optimal CpG DNA sequences for many vertebrate species are not yet known (p. 119). Further, Agrawal et al. teach that "The presence of unmethylated CpG dinucleotide is essential for the induction of immunostimulatory activity..." (See p. 114, bottom of second column). Agrawal also teaches that sequences required for CpG related immune stimulation varies from species to species, and indicates, "The optimal motif for recognition by human immune cells is 'GTCGTT or TTCGTT'" (p. 115). Thus indicating that an oligonucleotide of 6 nucleotides in length can function as an

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immunostimulatory agent in humans. Hartmann et al. (J. Immunology, 2000; 164:1617-1624) teaches that the oligonucleotide must be protected from nuclease degradation in order to be effective in vivo. Specifically, Hartmann teaches, "To have in vivo clinical utility, ODN must be administered in a form that protects them against nuclease degradation. The native phosphodiester internucleotide linkage can be modified to become highly nuclease resistant via replacement of one of the non-bridging oxygen atoms with a sulfur, which constitutes phosphorothioate ODN." (see p. 1618). Therefore, in order for an oligonucleotide to stimulate an immune response in vivo it must contain an unmethylated CpG motif, be at least 6 nucleotides in length, and be protected from nuclease degradation by comprising, for example, modified backbone linkage, such as a phosphorothioate linkage.

With respect to linkage modifications, combinations thereof or ribose nucleotides or combinations with deoxynucleotides and complexed or linked to biodegradable carriers; Weiner (J. Leukocyte Biology, 68:456-463, 2000) states that the molecular mechanisms of CpG oligonucleotides' immunostimulatory effects are not yet understood (see page 461). While the biological effects of some chemical modifications have been studied for CpG containing oligonucleotides, the incorporation and positioning of chemical modifications relative to the CpG dinucleotide are highly unpredictable (see Agrawal et al, Molecular Med, Today, 6:72-81, 2000, especially pp 78-80). Further, the state of the art teaches that the phosphorothioate analogs are the most potent in immune stimulation (see Zhao et al (Biochemical Pharmacology, 51:173-182, 1996, page 173 (abstract) and there is no evidence of record that any sequence that is not fully phosphorothiolated provides for immune stimulation in any model.

The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice (see i)(A), above), reduction to drawings (see i)(B), above), or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus (see i)(C), above). See *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406.

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A “representative number of species” means that the species, which are adequately described are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus. The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure “indicates that the patentee has invented species sufficient to constitute the gen[us].” See *Enzo Biochem*, 323 F.3d at 966, 63 USPQ2d at 1615; *Noelle v. Lederman*, 355 F.3d 1343, 1350, 69 USPQ2d 1508, 1514 (Fed. Cir. 2004) (Fed. Cir. 2004)(“[A] patentee of a biotechnological invention cannot necessarily claim a genus after only describing a limited number of species because there may be unpredictability in the results obtained from species other than those specifically enumerated.”). “A patentee will not be deemed to have invented species sufficient to constitute the genus by virtue of having disclosed a single species when ... the evidence indicates ordinary artisans could not predict the operability in the invention of any species other than the one disclosed.” In *re Curtis*, 354 F.3d 1347, 1358, 69 USPQ2d 1274, 1282 (Fed. Cir. 2004)(Claims directed to PTFE dental floss with a friction-enhancing coating were not supported by a disclosure of a microcrystalline wax coating where there was no evidence in the disclosure or anywhere else in the record showing applicant conveyed that any other coating was suitable for a PTFE dental floss.) On the other hand, there may be situations where one species adequately supports a genus. See, e.g., *Rasmussen*, 650 F.2d at 1214, 211 USPQ at 326-27 (disclosure of a single method of adheringly applying one layer to another was sufficient to support a generic claim to “adheringly applying” because one skilled in the art reading the specification would understand that it is unimportant how the layers are adhered, so long as they are adhered); In *re Herschler*, 591 F.2d 693, 697, 200 USPQ 711, 714 (CCPA 1979) (disclosure of corticosteroid in DMSO sufficient to support claims drawn to a method of using a mixture of a “physiologically active steroid” and DMSO because “use of known chemical compounds in a manner auxiliary to the invention must have a corresponding written description only so specific as to lead one having ordinary skill in the art to that class of compounds. Occasionally, a functional recitation of those known compounds in the specification may be sufficient as that description.”); In *re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 285 (CCPA 1973) (the phrase “air or other gas which is inert to the liquid” was sufficient to support a claim to “inert fluid media” because the description of the properties and functions of the air or

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other gas segmentizing medium would suggest to a person skilled in the art that appellant's invention includes the use of "inert fluid" broadly.).

The specification nor the claims provide any guidance in determining which of the CpG nucleic acids of the genus "CpG" will function as set forth in the method of the claimed invention.

8. Claim 1, 3-8, 10 are 12-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an immunogenic composition comprising a combination of 5 *C. trachomatis* antigens (PepA, LcrE, ArtJ, DNaK and CT398), does not reasonably provide enablement for a vaccine composition comprising a combination of *C. trachomatis* antigens that is less than 5 antigens. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

As stated above the specification does not enable a vaccine compositions comprising the *C. trachomatis* antigens as claimed. The specification teaches that "Vaccines according to the invention may either be prophylactic (i.e. to prevent infection) or therapeutic (i.e. to treat infection), but will typically be prophylactic. Accordingly, the invention includes a method for the therapeutic or prophylactic treatment of *Chlamydia trachomatis* infection in an animal susceptible to chlamydial infection comprising administering to said animal a therapeutic or prophylactic amount of the immunogenic compositions of the invention. Preferably, the immunogenic composition comprises a combination of *Chlamydia trachomatis* antigens, said combination selected from the group consisting of two, three, four, or all five *Chlamydia trachomatis* antigens of the first antigen group. Still more preferably, the combination consists of all five *Chlamydia trachomatis* antigens of the first antigen group."

The specification states that Figures 8(a)-8(d) show the results obtained after administration of a combination of five different CT antigens (CT045, CT089, CT396, CT398 and CT381) with complementary immunological profiles which demonstrate that this five antigen mix is capable of providing protection against CT challenge in a mouse model of Chlamydial genital infection when used in combination with an immunoregulatory agent, such as ALOH and CpG." (p. 77) There is no enablement for a vaccine composition of less than five

antigen mix. There is not indication which of the five *Chlamydia trachomatis* antigens is necessary/required to achieve vaccine protection when the vaccine composition comprises less than five *Chlamydia trachomatis* antigens.

It is noted that there is no Figure 8(d) in the drawing set or recited in the Brief Description of the Drawings.

Igietsme et al (*Infection and Immunity*, 2000, 68/12:6798-6806) discusses the problems of *Chlamydia* vaccines. “Despite considerable efforts and clinical and experimental evidence suggesting that at least partial protective immunity is feasible in humans, the development of reliable *Chlamydia* vaccines using conventional immunization strategies have proven to be elusive. Among other setbacks, vaccine effectiveness was relatively limited because of poor immunogenicity; more importantly, the use of inactivated whole-*chlamydia* agents appears to be unattractive due to likely immunopathogenic components.” (p. 6803)

Factors to be considered in determining whether undue experimentation is required, are Set forth in *In re Wands* 8 USPQ2d 1400. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art and (8) the breadth of the claims.

Applying the above test to the facts of record, it is determined that 1) no declaration under 37 C.F.R. 1.132 or other relevant evidence has been made of record establishing the amount of experimentation necessary, 2) insufficient direction or guidance is presented in the specification with respect to vaccine composition comprising less than five *C. trachomatis* antigens having vaccine protection, 3) the relative skill of those in the art is commonly recognized as quite high (post-doctoral level). One of skill in the art would require guidance, in order to make or use vaccine composition comprising less than five *C. trachomatis* antigens having vaccine protection. Without proper guidance, the experimentation is undue. In view of all of the above, in view of the lack of predictability in the art, it is determined that it would require undue experimentation to make and use the claimed invention.

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-8, 10, 12-16 and 22-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Grandi et al (WO 2003/049762, publication date June 19, 2003).

Grandi et al discloses polypeptides derived from *Chlamydia trachomatis* that are suitable for vaccine preparation, antigens and immunogens suitable for use in vaccine development (abstract; p. 1; claims). Grandi et al discloses that the compositions can comprise two or more proteins, *Chlamydia trachomatis* antigens (p. 7; claims). Grandi et al specifically disclose among others, CT398 (SEQ ID NO: 111), LcrE (SEQ ID NO: 61), HtrA (SEQ ID NO: 229), ArtJ (SEQ ID NO: 105), PepA (SEQ ID NO: 71), DnaK (SEQ ID NO: 107) and CT547 (examples; Table 1; claims). Grandi discloses the use of adjuvants in order to enhance immunogenicity (p. 7; pp22-25).

Since the Patent Office does not have the facilities for examining and comparing applicants' proteins with the proteins of the prior art reference, the burden is upon applicants to show a distinction between the material structural and functional characteristics of the claimed proteins and the proteins of the prior art. See In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and In re Fitzgerald et al., 205 USPQ 594.

11. No claims are allowed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 571-272-0860. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

N. M. Minnifield  
Primary Examiner  
Art Unit 1645

/N. M. Minnifield/  
Primary Examiner, Art Unit 1645